

REMARKS

Upon entry of the following amendments, claims 1 and 4-18 constitute the pending claims in the present application. Claims 2 and 3 have been cancelled by Applicants. Applicants have amended claims 1 and 14-17. No new matter has been added.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Office are addressed below in the order they appear in the prior Office Action.

1. Information Disclosure Statement – Missing References

The Office states that references C1-C75, B63 and B52 have not been considered contending that copies of these references were not provided. Applicants respectfully point out that the Office has previously acknowledged receipt of these references and note that a copy of the return postcard submitted with the Information Disclosure Statement of December 19, 2003 was *twice* stamped as received by the USPTO (See Exhibit A). However, to expedite prosecution, Applicants are resubmitting herewith copies of references C1-C75, B63 and B52.

2. Claim Rejections – 35 U.S.C. 101

Claims 14-16 are rejected under 35 U.S.C. 101 as being allegedly directed to non-statutory subject matter. Applicants have amended claim 14 to clarify and request reconsideration and withdrawal of the rejection.

3. Claim Rejections – 35 U.S.C. 102(b)

Claims 1-3, 7, 9-11, and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 6,042,534 to Gellman et al. (“Gellman”). Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

As noted above, Applicants have amended claims 1 and 17 to more precisely claim the sling assembly and method. Amended claims 1 and 17 recite in part “a biocompatible sleeve having a lumen, at least a portion of the sling being positioned within the lumen.”

Applicants respectfully submit that Gellman does not teach or suggest “a biocompatible sleeve having a lumen, at least a portion of the sling being positioned within the lumen” as required by amended claims 1 and 17. While Gellman teaches that “[a] coating may . . . be applied to the sling” (Gellman, column 8, line 3), Gellman does not teach or suggest that the

coating have a lumen or that at least a portion of the sling be positioned within the lumen of a sleeve as required by amended claims 1 and 17. Therefore, Applicants request reconsideration and withdrawal of the rejection of these claims and their respective dependent claims.

4. Claim Rejections – 35 U.S.C. 102(e) Over U.S. 2004/0225181 to Chu

Claims 1-3 and 13-18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 2004/0225181 to Chu et al. (“Chu”). Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

Regarding claims 1 and 17, the Office asserts that element 18 of Chu is a bioabsorbable sleeve. Without addressing the merits of this rejection, Applicants assert that the alleged bioabsorbable sleeve of Chu is subject matter that is not found in the Chu priority document, U.S. Provisional Patent Application No. 60/465,722, filed April 25, 2003 (the “Chu provisional”). As such, this subject matter is only entitled to the filing date of Chu, April 26, 2004. Considering the present application has a filing date of July 31, 2003, the portions of Chu that are not found in the Chu provisional, such as the subject matter relied on by the Office in issuing the present rejection, do not qualify as prior art under 35 U.S.C. 102(e). Accordingly, the portions of Chu that are available to support the present rejection have not been shown to anticipate all the features of the present claims. Applicants therefore request reconsideration and withdrawal of the instant rejection over claims 1 and 17 and those dependent thereon.

5. Claim Rejections – 35 U.S.C. 103(a) Over Gellman in view of U.S. 6,971,813 to Shekalim et al. and U.S. 5,935,172 to Ochoa et al.

Claims 4-6, 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gellman in view of U.S. 6,971,813 to Shekalim et al. (“Shekalim”) and U.S. 5,935,172 to Ochoa et al. (“Ochoa”). Applicants respectfully traverse the rejection to the extent that it is maintained over the claims as currently amended.

As explained above, Gellman does not teach or suggest all the features of amended claim 1. Applicants also assert that the teachings of Shekalim and Ochoa do not teach or suggest all of such features. Shekalim discloses the application of “liquid or semi-liquid” coating materials to a prosthesis. Shekalim, column 2, lines 7-9. But Shekalim does not teach or suggest, among other things, the use of such materials as a sleeve having a lumen, and in fact the “liquid or semi-

liquid” feature teaches away from the formation of a lumen within a sleeve. Ochoa also does not teach or suggest, among other things, any sleeve having a lumen. Accordingly, the references, even if combined with the teachings of Gellman, do not teach all the features of Applicants’ claims, and therefore the pending claims are not obvious over Gellman in view of Shekalim and Ochoa. Applicants consequently request reconsideration and withdrawal of the present rejection of claims 4-6, 8, and 12.

5. Claim Rejections – 35 U.S.C. 103(a) Over Chu in View of Shekalim and Ochoa

Claims 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu in view of Shekalim and Ochoa. Applicants submit that the claimed invention and Chu were, at the time the claimed invention was made, subject to assignment to Scimed Life Systems, Inc. Applicants accordingly assert that, under 35 U.S.C. 103(c), the subject matter disclosed in Chu is not available as prior art for a rejection under 35 U.S.C. 103(a) and therefore cannot be combined with the teachings of Shekalim and Ochoa. As neither Shekalim nor Ochoa teach or suggest all of the features of claims 4-12, Applicants respectfully request that the present rejection be withdrawn.

CONCLUSION

In view of the above remarks, Applicants believe the pending application is in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000.

Reply dated March 13, 2007
In Reply to Office Action of September 15, 2006

Application No. 10/631,364
Docket No.: MIY-P01-032

Applicants believe no fee other than that required for the above-mentioned three-month extension of time is due with this response. However, if an additional fee is due, please charge our Deposit Account No. 18-1945, under Order No. MIY-P01-032 from which the undersigned is authorized to draw.

Dated: March 14, 2007

Respectfully submitted,

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Exhibit A

BSC-293
(1002/1403)

The "RECEIVED" stamp of the Patent Office imprinted hereon acknowledges the filing of:

Transmittal Form (1 pg.); Information Disclosure Statement (2 pgs.); Form PTO-1449 (25 pgs.); copies of cited references B1-B87 and C1-C75; and this return receipt postcard, all mailed under a Certificate of First Class Mailing dated December 19, 2003.

Name of Applicants: Wagner et al.

Application Number: 10/631,364

Attys: J. Tosti/KERadcliffe

Date: December 19, 2003
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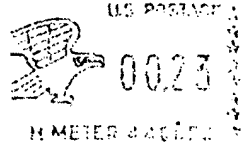
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Exhibit A (Continued)

~~TESTA, HURWITZ & THIBEAULT, LLP~~

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